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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/808,616 | 03/25/2004 | Michael Eck | A-9001.RNFMP/cat | 5012 |

7590 01/11/2007

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| EXAMINER | |
|---|---|
| COLLADO, CYNTHIA FRANCISCA | |
| ART UNIT | PAPER NUMBER |
| 3618 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|---|---|---|
| 3 MONTHS | 01/11/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/808,616 | ECK, MICHAEL | |
| | Examiner | Art Unit | |
| | Cynthia F. Collado | 3618 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *14 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *12-20* is/are allowed.

6)☒ Claim(s) *1-11 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

Applicant submitted an amendment dated June 14,2006.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 and 7-11are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al'070 (US Patent No.5, 342,070) in view of Chen'210 (US Patent No.6, 669,210).

Regarding claim 1, Miller discloses a tongue fastened to the cap like shoe tip but fails to teach an adjustable shoe tip, however Chen teaches an adjustable skate. It would have been obvious to one of ordinary skilled in the art at the time of the invention

was made to modify the skate of Miller to include a tongue attached to the tip of the skate in where the tongue of the skate can be adjusted by the tip of the skate of Miller to accommodate different foot sizes.

Regarding claims 2 and 21, Chen discloses the length of the shoe body section in the direction of the chassis is greater by a multiple of the length of the shoe tip (see figure 1, element 12 and 16).

Regarding claim 3, Chen discloses the claimed invention except for the length of the shoe body section in the direction of the chassis is at least 70% of the maximum total length of the shoe body. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to construct the length of the shoe body section in the direction of the chassis to at least 70% of the maximum total length of the shoe body, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller, 105 USPQ 233.*

Regarding claims 4 and 5, Chen discloses the laces reaching from the area of the shoe body section adjacent to the shoe tip to an upper shoe body opening and the lacing reaching from the shoe tip to an upper shoe body opening (see figure 1, element 28).

Regarding claim 7, Chen discloses the shoe tip is guided with a sole section on one guide provided on the chassis (see figure 1, element 47).

Regarding claim 8, Chen discloses a guide made of two rails at a distance from each other and extending parallel to each other in the longitudinal direction (see figure

5, elements 36 and 86), the two guide rails engage in a guide groove on the sole section of the shoe tip (see column3, lines 7-21).

Regarding claim 9, Chen discloses a locking device for locking the shoe tip (see figure 1, element 20).

Regarding claim 10, Chen disclosed a locking element with one catch that can slide in the chassis against the effect of springs and that act in combination with a counter catch on the shoe tip (see column 3, lines 22-42).

Regarding claim 11, Chen disclosed the catch comprising one tooth (see figure 2, element 68) and the counter catch comprising teeth of a toothed strip (see figure 2, element 74).

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al'070 (US Patent No.5, 342,070) in view of Chen (US Patent No. 6, 669,210) in further view of Crane et al (US Patent No.5, 234,230).

Regarding claim 6,the combination of Chen and Miller disclose a tongue fastened to the cap like shoe tip that can be adjusted but doesn't teach a impact guard, however Crane discloses a impact guard on one side located above a sole of the shoe body and below the lacing and extends from the heel area up to the vicinity of the shoe toe (see figure 1, element 36). Based on the teachings of Crane it would have been obvious to one of ordinary skilled in the art at the time of the invention was made to modify the shoe body of Miller and Chen to include a impact guard as in Crane so as to provide the protection required to the athletes entire foot and ankles.

### *Response to Arguments*

Applicant arguments see pages 7 and 8, filed June 14,2006, with respect to the 103(a) rejection of all claims have been fully considered and are not persuasive. The rejection of March 17, 2006 remains.

Applicant argued the rejection of claim 1 under 35 U.S.C 103(a) was improper because examiner relied upon Chen for showing an adjustable skate and concluded it would have been obvious to modify the skate of miller to include a tongue attached to the tip of the skate that is movable relative to the shoe body, however examiner directs applicant to the Miller reference in which the tongue is attached to the shoe tip as shown in figure 9, clearly one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). For these reasons, the rejection stands.

### *Allowable Subject Matter*

Claims 12-20 are allowed

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia F. Collado whose telephone number is (571)2728315. The examiner can normally be reached on mon-fri 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571)2726914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CFC

J. ALLEN SHRIVER
PRIMARY EXAMINER